IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Tomio Amano	
Serial No.	:	09/965,772	Examiner : Rachna Singh Desai
Filed	:	September 27, 2001	Art Unit : 2176
For	:	APPLICATION DATA ERROR CORRECTION SUPPORT	

October 17, 2008

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Box AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants hereby request review of the final rejection in the above-identified application. No amendments are being filed herewith. The review is requested for the reasons stated in the attached remarks.

Respectfully submitted,

I hereby certify that this correspondence and any documents referred to as enclosed therewith are being filed with the Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, by EFS Web on October 17, 2008.

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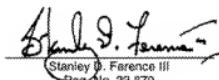
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REMARKS

In the Office Action dated July 17, 2008, pending Claims 1, 2, 4-11 and 20-24 were finally rejected. Claims 1, 4, 6, 8, 10, and 20-22 are independent; the remaining claims are dependent. Claims 1, 2, 4, 5, 6-11 and 20-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kantrowitz et al. (U.S. Patent No. 6,618,697 (hereinafter "Kantrowitz")) in view of DeMont (U.S. Patent No. 5,920,878 (hereinafter "DeMont"). Claim 24 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kantrowitz in view of DeMont and further in view of Kopec et al. (U.S. Patent No. 5,883,986 (hereinafter "Kopec")). Applicants respectfully request reconsideration.

Applicants respectfully submit that the Examiner has made impermissible combinations of the teachings of the prior art references using hindsight and has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Simply put, the Examiner does not provide any "clear articulation of the reason(s) why the claimed invention would have been obvious." MPEP § 2143.

The Examiner misconstrues Applicants' claim language. Claim 1 recites, *inter alia*, "***providing error correction support for application data written in a markup description language …***" Claim 1 (emphasis added). Thus, error correction support is provided for markup description language, not for text into a word processing document (as taught in Kantrowitz, Abstract), nor for augmenting binary code with a Hamming code (as taught in DeMont, Col. 3-4).

As best understood, Kantrowitz is directed toward "a method for rule-based correction of spelling and grammar errors." *Kantrowitz*, Title. Kantrowitz, even when

combined with DeMont, does not teach or suggest "providing error correction support for application data written in a markup description language that is to be exchanged between computing devices" as per claim 1. In this regard, Applicants object to the Examiner's use of the "Examiner note" (appearing on pp. 3, 5, 9, 12, 14 of the Office Action). Nowhere does Kantrowitz suggest, even when combined with DeMont, providing error correction support for documents written in a markup description language *that are exchanged between computing devices*, nor is there any other evidence supporting the "Examiner note".

As best understood, DeMont teaches a "method for hiding a binary encoded message in an electronic document by modulating the case of the characters in a case-intensive markup language." DeMont, Title. Nowhere does DeMont, even when combined with Kantrowitz, teach or suggest "defining a tag set to prevent errors or incorrect character conversions that occur frequently during the exchange and re-input of text in a markup description language used to write data or sentences" as per claim 1.

As the Examiner acknowledges "Kantrowitz does not explicitly teach defining a tag set to prevent errors or that the application data is written in a markup description language." *Office Action*, pp. 3. The Examiner thus cites DeMont's teaching regarding Hamming code to meet the limitation "…***defining a tag set to prevent errors; using the tag set to add rewritten information***." *Id* at pp. 4 (emphasis in original). Applicants respectfully disagree.

This is not how claim 1 reads. Rather, claim 1 reads "…***defining a tag set to prevent errors*** or incorrect character conversions that occur frequently during the

exchange and re-input of text in a markup description language used to write data or sentences; and *using a tag set to add rewritten information* to a predetermined portion of said application data written in a markup description language…" Claim 1. The Examiner cannot piece together the references to read against different portions *of the same claim limitation* without providing the underlying rationale for doing so.

Moreover, it is well established that "[i]f the proposed modification or combination of the prior art *would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.*" MPEP § 2143.01(VI) (citing *In re Ratti*, 270 F.2d 810 (1959)) (emphasis added). Here, the Examiner appears to suggest the "Hamming code" of DeMont can modify Kantrowitz's correction of characters in order to read on the "tag set" of the instant claims for providing correction support for markup description language. *Office Action*, pp. 4. Applicants respectfully disagree.

First, DeMont's Hamming code could not be used as a tag set for Kantrowitz's correction of characters, as the Hamming code is in binary form, augmenting the binary data after the data has been reduced to such a form, in order to hide messages within the document. *DeMont*, Col. 4, lines 18-56. Thus, adding "Hamming code" to Kantrowitz would not provide Kantrowitz with a "tag set" for error correction of any kind but would rather, at most, provide a means of hiding messages in a document.

Second, neither reference even suggests "…using a tag set to add rewritten information to a predetermined portion of said application data written in a markup description language …" as in claim 1. This is because DeMont's "Hamming code" is

not a tag set used for adding to markup description language, but is rather an insertion in the binary string. Thus, even if Kantrowitz could be modified to accept DeMont's Hamming code, this would not accomplish providing error correction for a markup description language.

Finally, it is well established that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03 (quoting *In re Wilson*, 424 F.2d 1382, 1385 (1970)). In the Office Action, the Examiner has not considered the words as they actually appear in the claims and has not even considered all the words appearing in the claims.

In addition to the Examples above, in rejecting claim 10, the Examiner states that "Kantrowitz teaches a method for correcting errors…which meets the preamble, ***an*** [sic] ***system for generating application data***." *Office Action*, pp. 13-14 (emphasis in original). There is no such preamble in claim 10. Claim 10 actually reads "…an arrangement which provides error correction support for application data written in a markup description language that is to be exchanged…" Moreover, the Examiner gives no consideration to the claim language "A computer system comprising: *a memory…*" Claim 10 (emphasis added). Applicants respectfully submit that the claim language, as written, must be considered when making the rejections.

In view of the foregoing, it is respectfully submitted that the Examiner has committed reversible error and that the application is in condition for allowance. Notice of such allowance is hereby earnestly solicited.